

P.3
RECEIVED
CENTRAL FAX CENTER

AUG 23 2010

Attorney Docket No.: 403047-A-01-US (Orbach)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Julian James Orbach

Application No.: 10/810,459

Confirmation No.: 9320

Filed: 03/27/2004

Art Unit: 2614

For: Method And Apparatus For Determining The
Presence Of The User By A
Telecommunication Terminal

Examiner: Nguyen, Khai N.

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is responsive to the Examiner's Answer mailed
06/23/2010.

This Reply Brief contains items under the following headings, as
recommended for reply briefs in M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to Be Reviewed on Appeal
- III. Argument

I. STATUS OF CLAIMS

The status of the claims is unchanged from that which was
previously stated in the Appeal Brief.

I hereby certify that this correspondence is being facsimile transmitted to Commissioner, at fax No. 571-273-8300,
on

08/23/2010
Date Being Faxed

John C. Moran
Signature

RECEIVED
CENTRAL FAX CENTER

AUG 23 2010

Application No.: 10/810,459

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are unchanged from that which was previously stated in the Appeal Brief

III. ARGUMENT

With Respect To Claims 1-5 and 9-12 rejected under 35 U.S.C. §102 (e)

Applicant has asserted that claims 1-5 and 9-12 are patentable under 35 U.S.C. §102 (e) over U.S. Patent No. 6,542,436 of V. Myllyla (hereafter referred to as Myllyla) because Myllyla does not disclose detecting the presence of the user rather discloses a system for determining if the mobile telephone is to be used in the hands-free-mode (mobile telephone away from the ear of the user) or handset mode (mobile telephone next to the ear of the user). In both modes, the user is clearly in the presence of the mobile handset. Myllyla clearly describes this type of operation in Column 1, lines 20-31, and Column 3, lines 9-15. Myllyla does not disclose or suggest detecting the presence of the user since Myllyla assumes that the user is present and is only trying to determine the location of the mobile telephone to the user's body.

In response to this argument, the Examiner's Answer of 06/23/2010, on Page 11, states "In response to the argument, the Examiner respectfully disagrees with Appellant's argument because Appellant is apparently reading limitations into the claim and arguing about features that are not claim, irrelevant to the claims or arguing a mere field of use (i.e., hands-free or handset mode) which is not recited anywhere in the claim. And thus Appellant's argument is improper because Appellant's argument is based on the relevant application such as hands-free/handset modes that is not claim."

Application No.: 10/810,459

First, Appellant has not stated that the claims recite an application such as hands-free/handset modes, but rather have stated that this is what Myllyla discloses. The Appellant has always maintained that the claims recite detecting the presence of the user. The Examiner's Answer is implying a position never taken by Appellant.

Second, the Examiner's Answer states on Page 12 "in response to the argument, Examiner respectfully disagrees with Appellant's argument for the following reasons: First, since the claim does not specify any definition or a limitation in the claim on the 'the presence of a user'. And it is up to one of ordinary skill in the art to take the broadest interpretation such that the user is present when the user's head is present." Appellant agrees with the Examiner's Answer that a user is present when the user's head is present. However, the disclosure of Myllyla assumes that the user is always present and only detects whether the mobile handset is in the hands-free or handset mode. The disclosure of Myllyla does not meet the requirements of M.P.E.P. §21314 for rendering the claims unpatentable under 35 U.S.C. §102 (e).

Appellant asserts that independent claim 1 is patentable under 35 U.S.C. §102 (e) over Myllyla. In addition, dependent claims 2-5 which are directly or indirectly dependent on independent claim 1 are patentable for the same reasons. In addition, claims 9-12 are patentable for the same reasons as claims 1-5.

With Respect To Claims 13-22 rejected under 35 U.S.C. §103 (a)

Claims 13-22 were rejected under 35 U.S.C. §103 (a) as unpatentable over Myllyla in view of U.S. Patent No. 5,680,450 of P.W. Dent, et al. (hereafter referred to as Dent). Appellant maintained that Myllyla does not disclose or suggest determining the presence or non-presence of the user as is clearly recited in independent claims 13 and 18.

Application No.: 10/810,459

With respect to this statement, the Examiner's Answer discusses, starting on page 14 through Page 15, that Myllyla discloses determining the presence because Myllyla discloses determining when the mobile handset is in the handset mode. However, there is no discussion of Myllyla disclosing determining the non-presence of the user. Since Myllyla assumes that the mobile handset is either being held in the hands-free-mode or in the handset mode, Myllyla clearly can not disclose determining the non-presence of the user to the mobile handset since the user is always present with respect to the mobile handset. The Examiner's Answer points out that the claims do not define "presence or non-presence" which means one skilled in the art would utilize the common definition for these terms. Clearly, one skilled in the art would not consider a mobile telephone being held in the hands-free-mode not to be in the presence of the user which is what is required by the Examiner's Answer for Myllyla to disclose determining non-presence. The argument with respect to the non-presence of the user is valid regardless of the Examiner's Answer concerning whether or not the presence of the user's head signifies the presence of the user to the mobile handset.

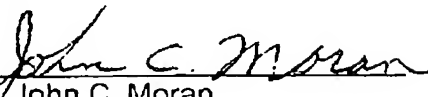
Clearly, claim 13 is patentable under 35 U.S.C. §103 (a) over the cited references. Claims 14-17 are directly or indirectly dependent on independent claim 13 and are patentable for the same reasons. Similarly, claims 18-22 are patentable for the same reasons as claims 13-17.

Conclusion

Applicant respectfully requests the board rule that the rejections of the claims are improper.

Application No.: 10/810,459

Respectfully submitted,

By 
John C. Moran

Attorney for Applicant
Reg. No.: 30,782

Date: 08/23/2010

Telephone No. (303) 450-9926